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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	13533.4033	6074
34313 7590 03/10/2009 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558				
EXAMINER				
PREBILIC, PAUL B				
ART UNIT		PAPER NUMBER		
3774				
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03/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,679

Applicant(s)

CUMMING, J. STUART

Examiner

Paul B. Prebille

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-124 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99-102 and 104-124 is/are rejected.
- 7) ☒ Claim(s) 106 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 58,60,62,64-71,75,76,78,79,81-84,87-89,92 and 96-98.

37 CFR 1.105 REQUIREMENT FOR INFORMATION

1. Applicant or the assignee of this application (if the assignee has undertaken the prosecution of the application) is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11(a) subsection G, applicant (or the assignee) is respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obviousness type double patenting. For example, claims 1-8 of US Patent 5,476,514, claims 1-42 of US Patent 5,674,282, and claims 1-9 of US Patent 6,051,024 appear to conflict with the presently claimed subject matter. Because the applicant (or the assignee) is presumably far more cognizant of the contents of the claims in these applications than

any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims.

3. Should applicant (or the assignee) believe that Double Patenting exists, then applicant (or the assignee) is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application. Applicant (or the assignee) should note that a terminal disclaimer is effective to overcome an obviousness type double patenting rejection, but will not overcome a "same type" double patenting rejection under 35 U.S.C. § 101.

4. Non-exhaustive list of possible related co-pending applications and patents:

5. 6051024
6. 5476366
7. 5674282
8. 6197059
9. 6494911
10. 6322589
11. 6342073
12. 09/943910
13. 6387126
14. 6638306

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15. 6451056
16. 7048760
17. 10/887,144
18. 11/297,233
19. 11/033,350
20. 10/977,233
21. 11/193,762
22. 11/325,225
23. 11/549,818
24. 11/360,019
25. 11/470,866
26. 11/459,862
27. 11/460,511.
28. 5496366
29. 6197059
30. 09/829,313
31. 10/057,691
32. 10/454,280
33. 10/888,163
34. 10/888,536

Election/Restrictions

Claims 58, 60, 62, 64-71, 75, 76, 78, 79, 81-84, 87-89, 92, and 96-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002 to prosecute Species IX (Figure 18). **Claim 65 is dependent upon a withdrawn base claim so it is withdrawn even though the Applicant argued that it was drawn to the elected invention. The status identifier is still incorrect and should be "withdrawn."**

Claim Objections

Claim 106 is objected to because of the following informalities: on line 11 of claim 106, the language "and wherein the optic" is a fragment that does not relate to any particular portion of the rest of the claim. It is grammatically awkward and difficult to understand as to its relationship with the remainder of the claim language. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90-91, 93-95, 99-102, and 104-124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The present claims are indefinite because "generally rectangular" is not used in the specification to describe the whole intraocular lens (IOL) rather this

terminology was used to describe only the central portion (33). No guidance was given as to how broadly to interpret this terminology; see MPEP 2173.05 (b), subsections (A), (C), (D), and (E) for similar modifying terms without guidance provided in the specification. Element (33) is considered to be the central portion of the IOL excluding the haptics that are separately labeled and reference numbered.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims s 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99, 102, 105-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuss et al (US 4,664,665) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Reuss et al (US 4,664,665) alone. Reuss anticipates the claim language where:

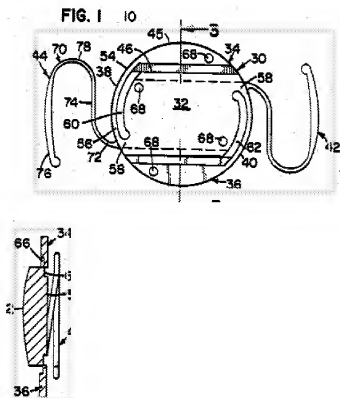
- the optic as claimed is the primary portion (32) of Reuss;
- a biconvex optic is taught on column 1, lines 32-39 and column 6, lines 51-60;
- the groove as claimed is groove (66) of Reuss;
- the haptic as claimed is secondary portion (34) or (36); it is elongate in the direction of the groove and it has a rectangular cross-sectional shape, (see Figure 3);

- the lens is capable of movement because it is foldable and has the same design as claimed; see Figures 1 to 10 and column 3, line 66 et seq.

In particular, "haptic" is defined as "tactile" by Dorland's Illustrated Medical Dictionary online at the web address of:
http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=/ppdocs/us/comm
[on/dorlands/dorland/four/000047159.htm](http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=/ppdocs/us/comm). Also, Merriam-Webster Online defines "haptic" as "relating to or based on the sense of touch" see the web address of <http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=haptic>. Since the secondary portions are at least capable of touching something and being palpated, these portions are "haptics" to the extent that this term can be give patentable weight. Furthermore, the Examiner asserts that the secondary portions are clearly plate haptics to the extent that they are flat, and thus, would not act as lenses to focus light. In other words, the secondary portions have all the properties that plate haptics do. The mere fact that the secondary portions are not called haptics does not mean that they are not haptics in both structure and function.

The term "near" (see line 13 of claim 53, for example) is interpreted as one of relative degree that is broad and does not preclude the structure of Reuss that is shown as being capable of being near the bag to the extent that this language can be given patentable weight.

The terminology "generally rectangular" is met by Reuss where the grey line (Figures 1 and 3 reproduced below) represents the generally rectangular shape in the following manner:



Alternatively, one may not consider the claim language met because one could argue that Reuss does not disclose a generally rectangular shape. However, the Examiner asserts that Reuss at least discloses a shape so close to generally rectangular that it would have been *prima facie* obvious to make the shape generally rectangular without changing the device appreciably.

Regarding claim 73, the anchors as claimed are met by the openings (68) of Reuss.

Regarding claim 77, the inner end has a groove in it so it is not as thick as the rest of the haptic.

Regarding claims 106 and 111, the haptics need not all be plate haptics so the knobs can be on the other haptics (42, 44) of Reuss.

Regarding claim 121, the claim language depends upon how the intraocular lens is inserted into the body. There is nothing preventing it from being used such that the "front" faces the retina and the "back" faces the cornea.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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